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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,296	05/30/2001	Tatsushi Nashida	450100-03302	7330
20999 7590 10/31/2007 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			EXAMINER HOSSAIN, FARZANA E	
			ART UNIT 2623	PAPER NUMBER
			MAIL DATE 10/31/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/870,296

Applicant(s)

NASHIDA ET AL.

Examiner

Farzana E. Hossain

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to communications filed 09/07/2007. Claims 1-6, 8 and 9 are pending. Claims 1-4 are amended. Claim 7 is cancelled. Claims 8 and 9 are new.

### ***Response to Arguments***

2. Applicant's arguments filed 09/07/2007 have been fully considered but they are not persuasive.

The applicant argues that Kuroda in view of Zigmond does not teach or suggest to insert advertisement information in a recorder program in addition to original commercial information.

In response to the argument, the claim language is in the alternative and can be met by inserting advertising information in a recorded program substituted for the original commercial information included in the recorded program. Nevertheless, Zigmond discloses both newly added limitations. Zigmond discloses inserting the advertising information in a recorded program in addition to original commercial information or any commercials that an advertiser can specify to be shown during a

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particular program without regard to the channel included in the recorded program and also some commercials or advertisements are overwritten based on timewise data (Column 12, lines 54-59, Column 14, lines 1-12) or substituted for the original commercial information included in the recorded program (Column 14, lines 1-12). Also, Zigmond discloses that one advertisement can be replaced versus all the advertisements (Figures 2A, 2B).

The applicant argues that claims 1, 4, 8 and 9 are patentable as 4, 8 and 9 are similar to claims 1. The applicant argues that claims that depend from claims 1 and 4 are patentable for same reasons.

In response to the arguments for claim 4 and dependent claims for claims 1 and 4, see response to the arguments for claim 1.

In response to the arguments, claims 8 and 9 are broader limitations than claim 1. There are no claim limitations for insertion of advertisements.

See new rejections.

3. The applicant failed to adequately traverse the facts noticed based on the failing 'to make a prima facie case with regard to claim 3.

In response to the arguments, the applicant continues to provide no specific arguments or evidence contrary to the examiner's conclusion regarding the noted fact. Therefore, applicant's remarks regarding a prima facie case of obviousness not being established are considered moot. See response to arguments for Claim 1.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 8 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Ellis et al (US 2003/0149988 and hereafter referred to as "Ellis").

Regarding Claims 8 and 9, Ellis discloses a recording system for recording and/or reserving a program and a recording substitution system for substitutionally recording a program (Figures 2a-e, 24) comprising:

A request accepting portion configured to accept a request to record and/or reserve a program (Figure 2, 24, 11, Page 5, paragraphs 0074-0078);

A storage portion configured to record a program (Figure 2, 24, 15, Page 5, paragraphs 0074-0078);

A connection portion configured to connect with an external device or the set top box or the local media server (Figure 2, 24, 20, Page 5, paragraphs 0074-0078, Figure 7, 31, 32);

A determination portion configured to determine whether it is possible to record a program requested to be recorded an/or reserved or determine if a certain number of requests have been made (Page 6, paragraph 0086) and

An issue portion configured to issue a recording substitution request to the external device via the connection portion automatically in response to negative result from the determination portion or not enough users have requested to program causing the program guide to record at a local media server or on a storage device (Page 6, paragraph 0086).

6. Claims 8 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Chihara (US 6,678,462).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding Claims 8 and 9, Chihara discloses a recording system for recording and/or reserving a program and a recording substitution system for substitutionally recording a program (Figure 4) comprising:

A request accepting portion configured to accept a request to record and/or reserve a program (Figure 3, S2, S3, S4, S6, Figure 4);

A storage portion configured to record a program (Column 5, lines 48-57, Column 6, lines 15-24, Figure 4);

A connection portion configured to connect with an external device or a connection means to another storage device (Column 5, lines 48-57, Column 6, lines 15-24, Figure 4, Figure 1);

A determination portion configured to determine whether it is possible to record a program requested to be recorded an/or reserved (Column 5, lines 48-57, Column 6, lines 15-24, Figure 4) and

An issue portion configured to issue a recording substitution request to the external device via the connection portion automatically in response to negative result from the determination portion (Column 5, lines 48-57, Column 6, lines 15-24, Figure 4).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 2, 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda (US 6,311,011) in view of Zigmond et al (US 6,698,020 and hereafter referred to as "Zigmond").

Regarding Claims 1 and 4, Kuroda disclose a recording system for recording and/or reserving a program (Figure 1) and a recording substitution system for substitutionally recording a program (Figure 1), comprising: means for accepting a request to record and/or reserve a program (Column 4, lines 18-50); storage means for recording a program (Column 4, lines 18-50, Figure 2, 103, 105); connection means for connecting with an external device (Column 5, lines 60-65); means for receiving a program (Figure 1, Figure 2) determination means for determination whether it is possible to record a program requested to recorded and/or reserved (Column 5, lines 60-65); means for issuing a recording substitution request to an external device via the connection means in response to a negative result of the determination (Figure 22, Figure 7). Kuroda discloses recording substitution means or the recorder/player for responding to reception of a recording substitution request via connection means and receiving and recording a corresponding in the storage means (Column 5, lines 60-65, Figure 7). Kuroda discloses the recoding system or recording substitution system receives and records television programs in the storage means or the external device, which inherently comprises commercials. Kuroda is silent on user information management means for storing user information about each requesting origin, and obtaining advertising information appropriate for a user attribute of the requesting origin via the connection means and the storage means permanently stores self-diagnostic data relating to content recording and reproducing sequences corresponding to expansion and compression of the original recorded program.



Zigmond discloses user information management means for storing user information about each requesting origin (Figure 5, 82), and obtaining advertising information appropriate for a user attribute of the requesting origin via the connection means to the external device and inserting the information in a recorded program or the household device or advertisement insertion device has a connection means to external devices including video tape or any other medium carrying recorded video programming which has the stored video program and advertisements appropriate for a user attribute is inserted into the recorded program (Figure 5, Figure 6, Column 7, lines 9-12, Column 11, lines 31-65). Zigmond discloses inserting the advertising information in a recorded program in addition to original commercial information or any commercials that an advertiser can specify to be shown during a particular program (Column 12, lines 54-9) included in the recorded program interpreted which is met by some commercials or advertisements are overwritten based on timewise data (Column 14, lines 1-12) or substituted for the original commercial information included in the recorded program (Column 14, lines 1-12).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kuroda to include that the user information management means for storing user information about each requesting origin (Figure 5, 82), and obtaining advertising information appropriate for a user attribute of the requesting origin via the connection means to the external device and inserting the information in a recorded program or the household device or advertisement insertion device has a connection means to external devices including video tape or any other

medium carrying recorded video programming which has the stored video program and advertisements appropriate for a user attribute is inserted into the recorded program (Figure 5, Figure 6, Column 7, lines 9-12, Column 11, lines 31-65) in addition to original commercial information or any commercials that an advertiser can specify to be shown during a particular program (Column 12, lines 54-9) included in the recorded program interpreted which is met by some commercials or advertisements are overwritten based on timewise data (Column 14, lines 1-12) or substituted for the original commercial information included in the recorded program (Column 14, lines 1-12 as taught by Zigmond in order to provide advertisements that are more interesting to the viewer for premium payment from the advertiser (Column 1, lines 23-35) as disclosed by Zigmond.

Regarding Claim 2, Kuroda and Zigmond disclose all the limitations of Claim 1. Kuroda discloses the determination means generates a negative result when a remaining capacity of the storage means is not sufficient for recording a broadcast program requested to be recorded and/or reserved (Figure 7, Column 5, lines 60-65).

Regarding Claim 5, Kuroda and Zigmond disclose all the limitations of Claim 4. Kuroda discloses when the recorder is connected with the Internet; the video recorder may store signals via World Wide Web in the temporary storage device (Column 12, lines 28-44). It is noted that the World Wide Web records data from a plurality of external devices (plurality of users) and the substitution means is located upstream from the user and records program per users requests.

Regarding Claim 6, Kuroda and Zigmond disclose all the limitations of Claim 4. Kuroda discloses comprising user information management means for storing user information about each requesting origin, wherein the recording substitution means records a broadcast program in a format appropriate for a user attribute of the requesting origin including HDD format, DVD format or VCR format (Figure 1, 105, Figure 7, Figure 22).

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda in view of Zigmond as applied to claim 1 above, and further in view of an applicant's admission of fact.

Regarding Claim 3, Kuroda and Zigmond disclose all the limitations of Claim 1. Kuroda and Zigmond are silent on the determination means generates a negative result when a failure in the system prevents a broadcast program from being recorded in the storage means. Applicant's admission of fact provides evidence to include redundant storage devices in the situation wherein a given storage device is not working or failing. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Kuroda and Zigmond to include the claimed limitation for the benefit of ensuring a program is recorded in situations of a recorder failing or not working.

***Double Patenting***

10. Applicant is advised that should claim 8 be found allowable, claim 9 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Farzana E. Hossain whose telephone number is 571-272-5943. The examiner can normally be reached on Monday to Friday 7:30 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FEH  
October 25, 2007

  
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